

## **REMARKS**

In response to the above-identified Action, Applicant seeks reconsideration thereof. Claims 11-16 are withdrawn. In this response, claim 1 has been amended, no claims have been added and no claims have been cancelled. Accordingly, Claims 1-10 are pending.

### **I. Amendments**

In the instant response, Claim 1 is amended to correct an informality and in particular to include the article “a” before the term “heater.” The title is further amended in response to the Examiner’s indication that the invention is not descriptive. Thus, the amendments do not add new matter and are supported by the specification. In view of the foregoing, Applicant respectfully requests consideration and entry of the amendments.

### **II. Information Disclosure Statement Objection Under 37 CFR §1.98(a)(2)**

In the outstanding Action, the Examiner refuses to consider the information disclosure statement (“IDS”) filed on 1/16/06 for failing to comply with 37 CFR §1.98(a)(2) and the IDS filed on 3/15/2005 for failing to comply with 37 CFR §1.98(a)(3).

The Examiner states the IDS filed on January 16, 2006 lists the document titled “Basic Requirements for Fiber Reinforced Plastic (FRP) Type 3HW Composite Cylinders” as having 20 pages yet the document submitted only included 19 pages. Applicant respectfully submits the document includes pages numbered 1-20, however, page 20 is a blank page. Applicant believes pages 1-20 were submitted with the IDS filed on January 16, 2006. Nevertheless, Applicant resubmits pages 1-20 of this document for the Examiner’s consideration.

The Examiner states the IDS filed on March 15, 2005 fails to comply with 37 CFR §1.98(a)(3) because DE 1110962 is not in the English language and a concise explanation is not provided. Applicant respectfully submits Applicant is not in possession of an English language translation of DE 1110962 and such a translation is not readily available therefore Applicant is

not required to provide the Examiner with such a copy. See 37 CFR 1.98(a)(3)(ii). Moreover, a concise explanation of the relevance of DE 1110962 is provided on page 1 of the Search Report dated February 16, 2005, a copy of which was enclosed with the IDS filed on March 15, 2006. In particular, it is stated that col. 3, lines 63-col. 4, line 61, claim 1 and figure 3 of DE 1110962 are relevant to claims 1-16. Thus, the requisite concise explanation was provided with the IDS filed on March 15, 2006. In addition, per a telephone conversation between Applicant's Attorney Stacie J. Sundquist and Examiner Butler on September 6, 2006, the Examiner indicated he had reconsidered the objection to the IDS on this basis and that the reference would be entered and considered.

The Examiner further points out that portions of paragraphs 2 and 3 of the IDS filed March 15, 2005 are inconsistent. In particular, Applicant inadvertently included a statement in the IDS that the information submitted was not considered previously in a counterpart application, however, cited to a Search Report for a counterpart PCT application in the IDS. Per a telephone conversation with Supervising Examiner Christine Johnson on September 6, 2006, the Supervising Examiner indicated it is clear from the IDS what Applicant intended to submit and that the statement was inadvertently included. The Supervising Examiner therefore concluded that it was not necessary for Applicant to submit a corrected IDS and that the IDS would be entered as filed.

For at least the foregoing reasons, the IDS filed on 1/16/2006 complies with 37 CFR §1.98(a)(2) and the IDS filed on 3/15/2005 complies with 37 CFR §1.98(a)(3). In view of the foregoing, Applicant respectfully requests consideration of the IDS filed on 1/16/2006 and the IDS filed 3/15/2005.

### **III. Claims Rejected Under 35 U.S.C. §102**

In the outstanding Action the Examiner rejects Claims 1-4, and 7 under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 4,132,104 issued to Clavin ("Clavin"). Applicant respectfully traverses the rejection for at least the reasons set forth below.

It is axiomatic that to anticipate a claim every element of the claim must be disclosed within a single reference. With respect to Claim 1, Applicant respectfully submits that Clavin fails to teach a method of bending a Composite Reinforced Pipe (CRF) including the element of heating the pipe as recited in Claim 1. The Examiner alleges “applying a material to a pipe” as recited in col. 4, lines 43-59 teaches a composite reinforced pipe and further that col. 1, line 57- col. 2, line 5 and Figure 1 teach heating the pipe prior to bending. Applicant respectfully disagrees with the Examiner’s characterization of Clavin. As provided in col. 3, lines 52-54 of Clavin, the coating is a “uniform continuous layer of plastic or resin.” As the phrase “composite reinforced pipe” suggests, however, and as further provided in Applicant’s specification, composite reinforcements are made up of a compilation of materials which provide reinforcement to the underlying pipe, such as, for example fiberglass-reinforced resins. See Application, page 1, paragraph [0003]. See also, the paper titled “Composite Reinforced Line Pipe” submitted with the Information Disclosure Statement dated February 27, 2004 for further discussion on composite reinforced pipes. It is clear from the foregoing that merely coating a pipe with plastic or resin does not make it a composite reinforced pipe. Moreover, nowhere within the teachings of Clavin is it taught that tearing of the coating during bending is prevented by heating the pipe itself. Instead, Clavin states in col. 1 that “the pipe coating at the outside of the bend is heated directly by resistance heating apparatus disposed at a specific area” (emphasis added). The coating is heated by the resistance heating apparatus to a temperature which will allow the coating to be stretched during bending of the pipe. See Clavin, col. 3, lines 33-40. A direct heating method such as that disclosed in Clavin does not teach the method of bending recited in Claim 1 wherein the pipe is heated. Thus, for at least the foregoing reasons, Clavin fails to teach a method of bending a CRF wherein the pipe is heated as required by Claim 1. Since each and every element of the claim is not taught by the reference, anticipation may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. §102(b) as being anticipated by Clavin.

In regard to dependent Claim 2, this claim depends from Claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in regard to Claim 1, Clavin fails to anticipate Claim 2. In addition, the failure of Clavin to teach a CRP and heating the pipe as

recited in Claim 1 necessarily prevents Clavin from teaching the element of “wherein the pipe is heated such that a composite temperature is slightly below a heat distortion temperature of the composite” as further recited in Claim 2. The Examiner alleges Clavin discloses a heating temperature which softens the coating without destroying it in col. 4, lines 43-col. 5, line 2 and therefore teaches this element. This is simply untrue. Although this portion of Clavin teaches initially heating the pipe to 600°F to bond the coating to the pipe, Clavin teaches that to avoid tearing of the coating when the pipe is bent, the coating, not the pipe, is heated to a much lower temperature (250°F – 400°F). Thus, for at least these additional reasons, anticipation may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 2 under 35 U.S.C. §102(b) as being anticipated by Clavin.

In regard to Claims 3-4 and 7, these claims depend from Claim 1 and incorporate the limitations thereof. Thus, for at least the reasons discussed in regard to Claim 1, Clavin fails to teach each and every element of Claims 3-4 and 7. Since each and every element of Claims 3-4 and 7 are not taught by Clavin, anticipation may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 3-4 and 7 under 35 U.S.C. §102(b) as being anticipated by Clavin.

#### **IV. Claims Rejected Under 35 U.S.C. §103**

A. In the outstanding Acton the Examiner rejects Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Clavin, and further in view of European Patent Application 1 086 760 A2 by Lewis ("Lewis"). Applicant respectfully traverses the rejection for at least the reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests every limitation of the claim such that the invention as a whole would have been obvious at the time the invention was made to one skilled in the art.

Claim 5 depends from Claim 1 and incorporates the limitations thereof. As previously discussed in regard to Claim 1, Clavin fails to teach or suggest at least the elements of a CRP and

heating the pipe as further required by Claim 5. The Examiner has not pointed to, and Applicant is unable to discern a portion of Lewis teaching these elements. Since each and every element of Claim 5 is not taught or suggested by Clavin or Lewis, alone or in combination, a *prima facie* case of obviousness may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 5 under 35 U.S.C. §103(a) as being obvious over Clavin in view of Lewis.

**B.** In the outstanding Acton the Examiner rejects Claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Clavin, and further in view of U. S. Patent No. 4,255,378 issued to Miller et al ("Miller"). Applicant respectfully traverses the rejection for at least the reasons set forth below.

Claims 8 and 10 depend from Claim 1 and incorporates the limitations thereof. As previously discussed in regard to Claim 1, Clavin fails to teach or suggest at least the elements of a CRP and heating the pipe as further required by Claims 8 and 10. The Examiner has not pointed to, and Applicant is unable to discern a portion of Miller teaching at least the element of a CRP.

In addition, there is no motivation to incorporate the plugs as taught in Miller into Clavin. As previously discussed, Clavin discloses a technique for bending a pipe without tearing a coating by directly heating the coating. Clavin does not contemplate heating the pipe prior to bending of the pipe as a way to prevent tearing of the coating much less a desire to retain heat within the pipe. Miller discloses a process for bending a plastic pipe wherein air is retained within the pipe using plugs at each end so that a pressure is created within the pipe which prevents pipe buckling during bending. See Miller, col. 5, lines 22-29. Nowhere within Miller is it contemplated that the trapped air facilitates heating of a coating or prevents tearing of an outer coating during bending of the pipe. Thus, upon review of the teachings of the references, one of ordinary skill in the art would not recognize incorporation of the plugs as disclosed in Miller to facilitate bending of a pipe without tearing a coating as taught by Clavin. Instead, it appears it is only upon review of Applicant's specification that one of ordinary skill in the art would be motivated to combine Clavin and Miller in the manner suggested by the Examiner. As the

Examiner is no doubt aware, such hindsight reconstruction is an inappropriate basis for combining references to render a claim obvious.

Thus, for at least the foregoing reasons, Clavin and Miller, alone or in combination, fail to teach or suggest each and every element of Claims 8 and 10. Since each element of the claims are not taught or suggested by the references, a *prima facie* case of obviousness may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 8 and 10 under 35 U.S.C. §103(a) as being obvious over Clavin in view of Miller.

C. In the outstanding Acton the Examiner rejects Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Clavin as applied to Claim 1, and further in view of U. S. Patent No. 2,480,774 issued to Rossheim ("Rossheim"). Applicant respectfully traverses the rejection for at least the reasons set forth below.

Claim 9 depends from Claim 1 and incorporates the limitations thereof. As previously discussed in regard to Claim 1, Clavin fails to teach or suggest at least the elements of a CRP and heating the pipe as further required by Claim 9. The Examiner has not pointed to, and Applicant is unable to discern a portion of Rossheim teaching at least the element of a CRP. Since each and every element of Claim 9 is not taught or suggested by Clavin or Rossheim, alone or in combination, a *prima facie* case of obviousness may not be found. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 9 under 35 U.S.C. §103(a) as being obvious over Clavin in view of Rossheim.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: September 7, 2006

By: Thomas Coester  
Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on September 7, 2006.

Jean Sweboda  
Jean Sweboda